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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|-------------------------|------------------|
| 09/459,240 | 12/10/1999 | HAMID BACHA | CA9-98-040 | 9886 |
| 7590 02/11/2005 JAMES E MURRAY 69 SOUTH GATE DRIVE POUGHKEEPSIE, NY 12601 | | | EXAMINER KIM, JUNG W | |
| | | | ART UNIT 2132 | PAPER NUMBER |

DATE MAILED: 02/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|--|--|---|--|
| <p align="center">Office Action Summary</p> | <p>Application No.</p> <p>09/459,240</p> | <p>Applicant(s)</p> <p>BACHA ET AL.</p> | |
| | <p>Examiner</p> <p>Jung W Kim</p> | <p>Art Unit</p> <p>2132</p> | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17,22 and 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17,22 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 17, 22 and 23 have been examined. Applicant in the after final amendment filed on January 19, 2005 amended claim 17, added new claims 22 and 23, and canceled claims 1-16 and 18-21. The remaining claims are found to be patentable over Frisch in view of Garfinkel; however the claims of copending application 09,459,239 and now patent 6,839,843, and the claims of patent 6,105,131, which both share at least one inventor (Carroll) and the same assignee (International Business Machines Corporation) with the instant application have been found to cover the invention claimed in the instant application.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 17, 22 and 23 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of Bacha et

al. U.S. Patent No. 6,839,843 (hereinafter Bacha '843) in view of claims 1-15 of Carroll
U.S. Patent No. 6,105,131 (hereinafter Carroll).

4. As per claim 17, Bacha '843 discloses a computer program product on a computer usable medium for maintaining a secure electronic data search system for a third party electronic data repository in which electronic data file documents are stored in encrypted form in the data repository to prevent access by the repository administrator such a system having a record listing document access privileges for each computer with access to electronic data stored in the repository the program product (see Bacha '843, claims 1-18) comprising:

- a. software for updating a manifest for an electronic data file document stored in the repository (see Bacha '843, claims 5 and 12 [col. 15:15-16, 29-34]);
- b. software for identifying all computers with access to the electronic data file document and for changing such access in an update software for communicating the change in access to all affected computers; software for updating access privileges records in all affected software; software for communicating the access privilege records to the affected computers (see Bacha '843, claims 5 and 15);
- c. software at the document originator to encrypt a document that it receives from the originator, prior to forwarding it onto the electronic data repository; software at the repository administrator which on receipt of the encrypted document, signs the encrypted document itself before storing the document in

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the electronic data repository and returns to the originator proof of deposition of the encrypted document (see Bacha '843, claims 1 [col. 12:54-61] and 8 [14:30-41], 18 [16:39-52]);

d. software at a requesting user to request the repository for use of the requested document; software in the repository to retrieve a copy of the document in encrypted form which is forwarded, along with the requester's identity, to the originator; software at the originator to verify that the requester is authorized to view the document from the access control list using an access control list identifying access ownership privileges for the document stored at the originator (inherent in the originator's environment to verify the requester is authorized to view the document from the access control list is the step of receiving the requester's identity); software at the originator when the requester has access to decrypt the document and forward the decrypted document directly to the requester (see Bacha '843, claims 1 [col. 12:62-13:12], 8, 10, 12 [15:35-43] and 18); and

e. software in the requester to provide proof of receipt of the decrypted document wherein the originators of the electronic data files, users of the electronic data files and the repository administrator all have environments which are secure extensions of their respective work space (see Bacha '843, claim 3).

5. The claims of Bacha '843 does not expressly recite vaults as environments of which are secure extensions of the originators of the electronic data files, users of the electronic data files and the repository administrator, and further wherein the software to

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forward, store, request, retrieve, and verify are in these vaults. Carroll discloses vaults as environments that are secure extensions linking users and secure servers by which access and transmission of information between the users and secure servers are securely handled. It would be obvious to one of ordinary skill in the art at the time the invention was made to combine the vaults claimed in Carroll with the product for maintaining a secure electronic data search system as claimed in Bacha '843, since the vaults of Carroll creates a more secure environment at the repository, originator and requestor to implement the product of Bacha '843. The aforementioned cover the limitations of claim 17.

6. As per claims 22 and 23, Bach '843 in view of Bach '131 covers a computer program product as outlined above in the claim 17 rejection. In addition, the product includes a system having a manifest to an electronic data document secure to the originator of the electronic document listing document access privileges for each computer with access to the electronic data document stored in the repository. See Bach '843, claim 5, especially col. 13:44-47 and claim 9, especially 14:61-64. The aforementioned cover the limitations of claim 22 and 23.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jung W Kim whose telephone number is (571) 272-3804. The examiner can normally be reached on M-F 9:00-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (571) 272-3799. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jung W Kim
Examiner
Art Unit 2132

Jk
February 8, 2005



GILBERTO BARRON
SUPERVISORY PATENT EXAMINER
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